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| 10/757,317 | 01/14/2004 | Mary Jo Winterer | AP35651 - 070457.1675 | 3521 |
| 21003 | 7590 | 11/27/2007 | EXAMINER | |
| BAKER BOTTS L.L.P. | | | LIU, CHIA-YI | |
| 30 ROCKEFELLER PLAZA | | | | |
| 44TH FLOOR | | | ART UNIT | |
| NEW YORK, NY 10112-4498 | | | PAPER NUMBER | |
| | | | 4172 | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DLNYDOCKET@BAKERBOTTS.COM

Office Action Summary

Application No.

10/757,317

Applicant(s)

WINTERER ET AL.

Examiner

CHIA-YI LIU

Art Unit

4172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 5-17-2004.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

Conclusion

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Bucci (US 6,786,400).

As per Claims 1, 5

Bucci ('400) discloses,

a consumer depository account (checking account) maintained by a first (second) financial institution holding funds on behalf of said consumer, see Fig 3 (345, 350) and column 2, lines 6-9.

a payment card (multifunctional card) for conducting one or more transactions and incurring charges associated with each such transaction, said card being

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issued to said consumer by a second (first) financial institution, see column 2, lines 2- 9.

said card further being linked to said depository account (checking account) maintained at said first institution for covering said charges, see column 2, lines 6-14 and column 4, lines 20-23.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3, 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bucci (US 6,786,400) in view of Bueche (US 6,834,269)

As per Claims 2, 6

Bucci ('400) does not specifically disclose deducting means for automatically deducting from said depository account on a periodic basis an amount to pay a portion or all of said charges

Bueche ('269) teaches deducting means for automatically deducting from said depository account (checking account) on a periodic basis an amount (monthly service fee) to pay a portion or all of said charges, see column 4, lines 60-64.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bucci's invention to include deducting means for automatically deducting from said depository account on a periodic basis an amount to pay a portion or all of said charges.

One of the ordinary skill in the art would be motivated to do so, for the benefit of saving time and preventing late payment.

As per Claims 3, 7

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Bucci ('400) further discloses a credit limit is associated with said card, which limit is reduced based on said charges, and refreshed automatically as a function of said deducting means, see column 11, lines 4-5. (It is inherent that credit card has a credit limit and the limit (the amount you are allowed to spend) is reduced every time you use it to purchase something. It is also inherent that credit card limit is refreshed automatically every month)

Claims 4, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bucci (US 6,786,400) in view of Bueche (US 6,834,269), and further in view of Weissman (US 6,353,811)

As per Claims 4, 8

Bucci ('400) does not specifically disclose billing means operated by said second financial institution for periodically informing said consumer of said charges made on the card and of the amount received from said consumer depository account to cover said charges

Weissman ('811) teaches billing means (billing statement) operated by said second financial institution for periodically informing said consumer of said charges made on the card and of the amount received from said consumer depository account to cover said charges, see Abstract of Weissman (lines 17-22) and Fig 2A.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bucci's invention to include billing means operated by said second financial institution for periodically informing said consumer of said charges made on the card and of the amount received from said consumer depository account to cover said charges.

One of ordinary in the skill would be motivated to do so, for the benefit of allowing customers to keep track of the balance and avoiding over-spending.

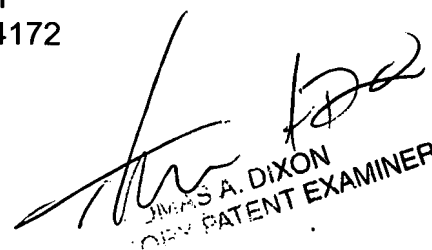
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHIA-YI LIU whose telephone number is (571) 270-1573. The examiner can normally be reached on Mon-Thur alternating Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TOM DIXON can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CHIA-YI LIU
Examiner
Art Unit 4172



JAMES A. DIXON
SENIOR PATENT EXAMINER